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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,933	11/30/2000	Kyu Dong Kim	07660002US	2877
58027	7590	06/09/2009		
H.C. PARK & ASSOCIATES, PLC 8500 LEESBURG PIKE SUITE 7500 VIENNA, VA 22182				
EXAMINER				
BOSWELL, BETH V				
ART UNIT		PAPER NUMBER		
3623				
NOTIFICATION DATE		DELIVERY MODE		
06/09/2009		ELECTRONIC		

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* KYU DONG KIM,  
9 YOUNG HOON KIM, BYUNG KWON KWAK,  
10 and GAB YOUL LIM  
11

12  
13 Appeal 2008-002704  
14 Application 09/725,933  
15 Technology Center 3600  
16

17  
18 Decided:<sup>1</sup> June 8, 2009  
19

20  
21 Before HUBERT C. LORIN, LINDA E. HORNER, and  
22 ANTON W. FETTING, *Administrative Patent Judges*.  
23  
24 FETTING, *Administrative Patent Judge*.  
25  
26

27  
DECISION ON APPEAL

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Kyu Dong Kim, Young Hoon Kim, Byung Kwon Kwak, and Gab Youl Lim (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-17 and 19-43, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a system that comprises a host computer, an administrator, a web client, a process designer, and a form designer. The administrator controls the whole aspect of the system and the web client is a tool with which the general user works on the system. The process designer defines each process that could be a component of the business procedure. The process designer may define a sub-process, a mail, an agent, SQL query and so on. These activities are basic components of the business procedure. The form designer generates a form that can be used in the business procedure. By using basic templates and modifying them, a user can easily generate a form that he or she wants. The generated form can also embed in the cells such functions as conditional branches, scripts, data exchanges, and/or computations. (Specification 3:1-12).

An understanding of the invention can be derived from a reading of exemplary claims 1 and 32, which are reproduced below [bracketed matter and some paragraphing added].

1. A workflow management system for automating a business process, comprising:

[1] a computer;

[2] an administrator executable by the computer,

- 1                wherein the administrator manages automating the  
2                business process and comprises  
3                an organization manager,  
4                a role/group manager,  
5                an authority manager,  
6                a process manager, and  
7                a folder manager;  
8                [3] a process designer executable by the computer,  
9                wherein the process designer  
10               determines flows and properties of the business  
11               process and  
12               defines an activity that is performed in the business  
13               process;  
14               [4] a database accessible by both the administrator and the  
15               process designer,  
16               wherein the database stores  
17               organization information,  
18               authority information, and  
19               folder information  
20               relating to the business process;  
21               [5] a process engine executable by the computer,  
22               wherein the process engine  
23               executes the business process and allocates the  
24               activity to the participant,  
25               monitors a start and end of the activity,  
26               facilitates storing a result of the activity, and/or  
27               interfaces with  
28               the database,  
29               another workflow engine, and/or  
30               a business application program;  
31               [6] a web client, that interfaces with  
32               the process engine,  
33               the another workflow engine, and/or  
34               the business application program, and  
35               wherein the web client permits a user to interact with the  
36               system; and  
37               [7] a form generator executable by the computer,  
38               wherein the form generator designs and operates an  
39               electronic form related to the business process, and

wherein the form generator interfaces with  
the database,  
the process designer,  
the process engine, the web client, and/or  
the business application program.

32. A method for automating a business process, the method  
comprising steps of:

- [1] modeling the business process,  
wherein the step of modeling includes generating an  
organization chart;
- [2] defining an activity that is performed in the business  
process;
- [3] accessing, from a database,  
organization information,  
authority information, and/or  
folder information  
relating to the business process;
- [4] executing the business process,  
wherein the step of executing the business process  
includes  
allocating the activity to a participant, and  
designing and  
creating an electronic form related to the business  
process; and
- [5] monitoring the business process,  
wherein the step of monitoring the business process  
comprises  
monitoring a start and end of the activity,  
facilitating storing a result of the activity, and/or  
interfacing with a workflow program and/or  
business application program.

This appeal arises from the Examiner's Final Rejection, mailed June  
27, 2006. The Appellants filed an Appeal Brief in support of the appeal on  
December 27, 2006. An Examiner's Answer to the Appeal Brief was mailed  
on July 17, 2007. A Reply Brief was filed on September 17, 2007. An oral  
argument was presented on May 14, 2009.

PRIOR ART

The Examiner relies upon the following prior art:

Berg	US 5,999,911	Dec. 7, 1999
Bacon	US 6,430,538 B1	Aug. 6, 2002

REJECTIONS

Claims 1-13, 19-20, 24, 26, and 28-31 stand rejected under 35 U.S.C. § 102(e) as anticipated by Bacon.

Claims 14, 16, 17, 25, 27, and 32-43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bacon.<sup>2</sup>

Claims 15 and 21-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bacon and Berg.

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-13, 19-20, 24, 26, and 28-31 under 35 U.S.C. § 102(e) as anticipated by Bacon turns primarily on whether Bacon describes a form generator that designs and operates an electronic form related to the business process as in limitation [7] of claim 1.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 14, 16, 17, 25, 27, and 32-43 under 35 U.S.C. § 103(a) as unpatentable over Bacon turns primarily on whether Bacon describes designing and creating an electronic form related to a business process as in limitation [4] of claim 32.

1 The issue of whether the Appellants have sustained their burden of  
2 showing that the Examiner erred in rejecting claims 15 and 21-23 under 35  
3 U.S.C. § 103(a) as unpatentable over Bacon and Berg turns primarily on the  
4 above rejection under 35 U.S.C. § 103 over Bacon.

5  
6 FACTS PERTINENT TO THE ISSUES

7 The following enumerated Findings of Fact (FF) are believed to be  
8 supported by a preponderance of the evidence.

9 *Bacon*

- 10 01. Bacon is directed to a workflow management system that  
11 provides personal subflow processing. A personal subflow  
12 definition is not bound to an explicit set of actors and thus  
13 improves re-usability (Bacon 4:5-9).
- 14 02. The primary components are a process definition tool, server,  
15 agents, database, and client and may further include an  
16 administration interface, LDAP (Lightweight Directory Access  
17 Protocol) services, certificate services, and an HTTP server  
18 (Bacon 4:15-20).
- 19 03. The server, the engines, and certain aspects of the client are  
20 implemented with the Java programming language. Likewise,  
21 though it is agent implementation-specific, the agents may be  
22 implemented in Java. The flow engine and server interact with the  
23 database, implemented as an Object Database Management

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<sup>2</sup> The statement of the statutory basis for the rejection (Answer 14) does not include claim 32-43, but the analysis of the rejection does include these claims (Answer 20-28).

Group-compliant (ODMG-compliant), object-oriented database, that is a multi-transaction and multi-threaded database that, among other things, provides Java bindings to facilitate persistence of the Java objects used in implementing the server and engines. Work items are similarly implemented using Java, but extended to improve persistence via the database (Bacon 5:23-51).

04. In defining the activities that constitute a personal subflow, the developer specifies the activities to be performed and associates predefined HTML pages with the activities analogously to that described in section 2 above. The HTML pages effectively display forms that display some or all of the work item contents to the participant and that are used to receive participant-entered data (Bacon 9:20-26).

*Facts Related To The Level Of Skill In The Art*

05. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, management control systems, and database management. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*Facts Related To Secondary Considerations*



06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

## PRINCIPLES OF LAW

### *Anticipation*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

### *Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: "[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at

issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420.

#### ANALYSIS

*Claims 1-13, 19-20, 24, 26, and 28-31 rejected under 35 U.S.C. § 102(e) as anticipated by Bacon.*

Claim 1 is the sole independent claim in this rejection. The Examiner found that Bacon anticipated claim 1. The Appellants contend that Bacon fails to describe an executable administrator as in limitation [2] or a form generator that designs forms as in limitation [7].

We agree with the Appellants as to the absence of a form generator. The Examiner found that Bacon described a Java applet and further found

1 that the Java applet is a form generator (Answer 5-6). The Examiner  
2 premised this on the finding that a form generator supports the various kinds  
3 of graphic objects, data input cells, graphic signatures, automatic  
4 calculations, database access and programming scripts based on the  
5 Specification at page 16 (Answer 33).

6 This is simply erroneous logic. It is premised on the assertion that if  
7 A implies B and B is true, then A is true. This is incorrect. The truth table  
8 for such an implication is that either A is false or B is true. Such implication  
9 does not show that A is true. Thus, the fact that a form generator supports  
10 various kinds of graphic objects and Bacon's Java applet also supports  
11 similar various kinds of graphic objects (FF 03) does not imply that Bacon's  
12 Java applet is a form generator.

13 The Examiner also cites Bacon 7:1-3 for an explicit recitation of a  
14 form generator (Answer 33). This portion recites a participant selecting an  
15 iconic "representation of a work item in the client's task manager window.  
16 The selection causes a selection message to be sent to the server 110  
17 indicating that a given work item has been selected." The Examiner does  
18 not explain how this recitation describes a form generator that designs  
19 forms, and we do not find that it does describe such a form generator.

20 We do not find any description separate from that found by Examiner  
21 of such a form generator that designs forms in Bacon. The only form  
22 explicitly described by Bacon is a predefined HTML form (FF 04). Since it  
23 is predefined, by definition it is not designed by the generator.

24 Thus, the Examiner erred in finding that Bacon describes the form  
25 generator that designs forms. Since this finding is sufficient to show  
26 reversible error of the Examiner's rejection, we need not reach the question

of whether an executable administrator is described. The remaining claims depend from claim 1 and incorporate the same form generator limitation.

*Claims 14, 16, 17, 25, 27, and 32-43 rejected under 35 U.S.C. § 103(a) as unpatentable over Bacon.*

Claim 32 is the sole independent claim in this group. Claims 14, 16, 17, 25, and 27 depend from claim 1.

The Examiner found that Bacon described the limitations of claim 32 except for the organization chart of limitation [1] (Answer 20-21, referring back to the analysis of claim 14 at Answer 15-16). The Appellants contend that again no design of forms is described as in limitation [4] (Br. 12) and also argue the absence of any motivation to modify Bacon (Br. 9-10).

We agree with the Appellants as to the absence of the designing of forms for the same reasons we found *supra*. The Examiner provided no additional findings as to the form design that would overcome the absence of such a showing in the prior rejection under anticipation. The remaining claims depend from either claim 1 or 32 and accordingly also contain the limitation of forms design that is not found in Bacon. Since this finding is sufficient to show reversible error of the Examiner's rejection, we need not reach the question of whether motivation to modify Bacon was properly found.

*Claims 15 and 21-23 rejected under 35 U.S.C. § 103(a) as unpatentable over Bacon and Berg.*

These claims depend from claim 1 and accordingly also contain the limitation of a form generator that designs forms that is not found in Bacon.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-13, 19-20, 24, 26, and 28-31 under 35 U.S.C. § 102(e) as anticipated by Bacon.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 14, 16, 17, 25, 27, and 32-43 under 35 U.S.C. § 103(a) as unpatentable over Bacon.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 15 and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Bacon and Berg.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-13, 19-20, 24, 26, and 28-31 under 35 U.S.C. § 102(e) as anticipated by Bacon is not sustained.
- The rejection of claims 14, 16, 17, 25, 27, and 32-43 under 35 U.S.C. § 103(a) as unpatentable over Bacon is not sustained.
- The rejection of claims 15 and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Bacon and Berg is not sustained.

REVERSED

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